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September 20, 2021

VIA ECF and E-MAIL - Failla NYSDCChambers@nysd.uscourts.gov

Hon. Katherine Polk Failla
United States District Court
Southern District of New York
40 Foley Square
New York, New York 10007

MEMO ENDORSED

Re: *Jacob's Jewelry Co., Ltd. v. Tiffany and Company et al.*
Civil Action No.: 1:20-cv-04291 (KPF)

Dear Judge Failla:

We are counsel to Plaintiff, Jacob's Jewelry Co. ("Jacob's") in the above-caption matter, and write this pre-motion letter to initiate a motion to compel the Defendant Tiffany and Company et al. ("Tiffany") to produce the documents requested in Jacob's Document Request Nos. 1-5 and 7.

The Document Requests (Nos. 1-15) were served On August 9, 2021 and Tiffany responded on September 9, 2021, objecting to all of them. The required "meet and confer" was held on September 17, 2021 and an email communication from Jacob's counsel (Max Moskowitz) to Tiffany's counsel (Rae Crisler) reflecting the "meet and confer" is attached.

Relative to Document Requests Nos. 1-5 and 7, Tiffany stated:

Tiffany is in the process of attempting to identify relevant materials responsive to this request **but cannot respond until Plaintiff serves its infringement contentions** and provides fair notice to Tiffany of the products Plaintiff accuses of infringement. After Plaintiff does so, and to the extent that the material requested by these Requests exists and is kept in the ordinary course of business, Tiffany may supplement its response to this request.

During the "meet and confer", Tiffany's counsel elaborated that Tiffany will not produce any of the requested documents prior to the date on which it is required to serve Tiffany's Invalidity Contentions, i.e., prior to about December 9, 2021. In response to the undersigned inquiry what justifies or permits delaying the document production to December, Tiffany's counsel responded that it established in the patent-related case law and practice that patent defendants are not obligated to produce "prior art" to the patent in suit,

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prior to the date on which the Invalidity Contentions are due. Jacob's is not aware of any such case law or patent practice.

As to the other Document Requests, namely Requests Nos. 6 and 8-15, Tiffany responded to each request with the refrain:

Subject to and without waiving the foregoing general and specific objections, Tiffany will conduct a reasonable search for and produce relevant, non-privileged documents concerning , ending with a reference to the requested documents in each specific request.

Thus, Jacob's is left in the dark as to when Tiffany intends to produce any documents, if ever.

Respectfully, there is no patent practice rule or case law that permits a patent defendant to delay producing requested prior art and similar documents until after it first serves its "Invalidity Contentions." Therefore, the Court should compel Tiffany to produce the requested documents.

Respectfully submitted,

OSTROLENK FABER LLP

/s/ Max Moskowitz
Max Moskowitz

Attorney for Plaintiff, Jacob's Jewelry Co, Ltd.

MM:MM
Attachment

cc: Counsel for Defendants (via ECF)

The Court is in receipt of Plaintiff's above letter. Defendant is directed to file a responsive letter on or before **September 24, 2021**.

Dated: September 21, 2021
New York, New York

SO ORDERED.

A handwritten signature in blue ink, reading "Katherine Polk Failla".

HON. KATHERINE POLK FAILLA
UNITED STATES DISTRICT JUDGE